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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,147	11/21/2000	Subhash C. Roy	TRA-ONEX-002	1902

7590 09/10/2003
David P. Gordon, Esq.
65 Woods End Road
Stamford, CT 06905

EXAMINER

NGUYEN, BRIAN D

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 09/10/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,147

Applicant(s)

ROY ET AL.

Examiner

Brian D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-17, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 6-10 and 18-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 1-24 are objected to because of the following informalities:

Claim 1, "requests" in line 6 seems to refer back to "requests" in line 4. If this is true, it is suggested to change "requests" in line 6 to ---the requests---.

Claim 13, "requests" in line 7 seems to refer back to "requests" in line 4. If this is true, it is suggested to change "requests" in line 7 to ---the requests---.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 2, 12-14, and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8, and 9 of copending Application No. 09/717,999. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claimed invention are described in claims 1, 6, 8, and 9 of copending Application No. 09/717,999 with different wording and/or arrangement.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 12-14, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651).

Regarding claims 1 and 13, Gorshe discloses a method comprising generating a repeat data frame having a plurality of rows (see col. 1, lines 44-46); making requests for space (see col. 3, lines 29-37; col. 6, lines 62-68; and Figure 5); and granting the requests through an out-of-band link (see lines 531-533 of Figure 5). Gorshe does not specifically disclose the request is made during row N for space in row N+1. However, it would have been obvious that the request be made during row N for space in row N+1 because space could be provided in any row subsequent to row N and no unexpected result is produced by providing space in row N+1.

Regarding claims 2 and 14, Gorshe further discloses each request includes through-the switch routing information and priority level information (see col. 3, lines 61-63).

Regarding claim 12 and 24, Gorshe further discloses the requests are made out-of-band (see lines 531-533 of Figure 5).

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6. Claims 3-4 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651) in view of Chiussi et al (5,689,506).

Regarding claims 3-4 and 15-16, Gorshe discloses all the claimed subject matter as described in previous paragraph except for explicitly disclose that the switch is a multistage switch and buffering the request at each stage of the switch. However, multistage switch and buffering the request at each stage of the switch is well known in the art. Chiussi discloses a system using multistage switch and buffering the request at each stage of the switch (see abstract; Figure 11; and col. 3, lines 13-26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the multistage switch and buffering the request at each stage of the switch as taught by Chiussi in the system of Gorshe so that more switching can be performed by the switch.

7. Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651) in view of Bergantino et al (6,359,891).

Regarding claims 5 and 17, Gorshe discloses all the claimed subject matter as described in previous paragraph except for a 52-byte chunk. However, Bergantino discloses a 52-byte chunk (see col. 15, lines 27-28). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the technique as taught by Bergantino in the system of Gorshe in order to meet specific needs.

8. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651) in view of Chow et al (6,148,349).

Regarding claims 11 and 23, Gorshe discloses all the claimed subject matter as described in previous paragraph except for the requests are made in-band. However, Chow discloses the

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use of in-band and out-of-band links for transmission of messages (see col. 26, lines 26-27).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use in-band for the requests as taught by Chow in the system of Gorshe since the use of in-band or out-of-band is a matter of design choice.

Allowable Subject Matter

9. Claims 6-10 and 18-22 would be allowable if rewritten to overcome the objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 8/6/03 have been fully considered but they are not persuasive.

The applicant argues that the requests are made in one row are for space in the very next row and not for any other row. This argument is not persuasive because space could be provided in any row subsequent to row N and no unexpected result is produced by providing space in row N+1.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Nguyen whose telephone number is (703) 305-5133. The examiner can normally be reached on 7:30-6:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms can be reached on (703) 305-4703. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

BN
8/26/03



DOUGLAS OLMS
SUPERVISORY PATENT EXAMINER
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